

REMARKS

The Applicant thanks the Examiner for the careful review of the specification. Reconsideration of the application is respectfully requested based on the the above amendments and the following remarks.

As a preliminary matter, the Applicant respectfully requests an initialed copy of the Form PTO-1449 attached to the Information Disclosure Statement filed on March 3, 2003, or if the Information Disclosure Statement has not already been considered, prompt consideration of the same. In addition, the Applicant respectfully requests that the Examiner acknowledge the claim to domestic priority under 35 U.S.C. § 120, since a specific reference was included in the first sentence of the specification.

I. Status of the Claims

Claims 1–22 and 24 are pending in the application. Claims 1, 10, 19, 21 and 23 are independent claims. Claims 2–9, 20, and 24 depend, directly or indirectly, from claim 1; claims 11–19 depend, directly or indirectly, from claim 10; and claim 22 depends from claim 21.

Claim 24 was objected to because of minor informalities in the claim.

Claims 1–22 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 4,438,953 (“Timme”).

II. Amendments

Claim 24 was objected to as including informalities. Claim 24 is amended, as the Examiner has suggested, to correct formal deficiencies in the claim. The amendments are minor, and no new matter is added.

III. Rejections under § 102

Claims 1–22 and 24 were rejected under 35 U.S.C. § 102 as being anticipated by Timme. This rejection is respectfully traversed because Timme does not disclose all of the limitations in the independent claims.

Independent claims 1, 10, and 21 all include the limitation of “a wear indicator that extends from” a shoulder of the connection. This limitation is not disclosed in Timme.

Timme discloses a benchmark (27 in FIG. 4) and a shoulder (17 in FIG. 4). The distance between the benchmark and the shoulder serves to indicate if the shoulder has been redressed and whether the shoulder is able to provide sufficient compression such that the tool joint is suitable for further use. Col. 2, ll. 55–66.

In a previous response, the Applicant argued that element 17 is a shoulder and not a wear indicator. The Examiner now asserts that Timme shows a wear indicator, taken to be element 17, extends from a shoulder, taken to be element 19 or 23. The Applicant respectfully submits that elements 19 and 23 cannot be a shoulder because neither is a shoulder, as that term is known in the art. With this Reply, the Applicant submits the Declaration of Robert S. Sively, IV. Mr. Sively stated that a shoulder is defined in the art as something that prevents further relative rotation between a pin and box member. Element 19, a beveled edge, does not prevent relative rotation between the pin member and the box member. Element 23 is a recess, and it does not prevent relative rotation between the pin member and the box member. Thus, neither element 19 nor element 23 may be a shoulder.

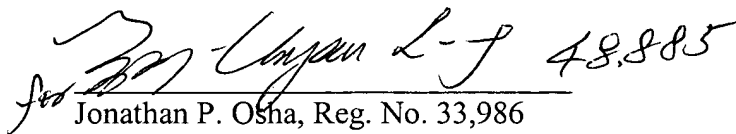
Because neither element 19 nor element 23 is a shoulder, as that term is known in the art, Timme does not disclose a wear indicator that extends from a shoulder. Thus, Timme does not disclose all of the limitation in the claimed invention. Thus, independent claims 1, 10, 21, and 23 are patentable over Timme. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

CONCLUSION

The above amendments and remarks are believed to require no further prior art search. Also, Applicant believes that this reply is responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Because the amendments and remarks simplify the issues for allowance or appeal, and do not constitute new matter, entry and consideration thereof is respectfully requested. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09432/168002).

Respectfully submitted,

Date: 7/12/04

 48,885

Jonathan P. Osha, Reg. No. 33,986
OSHA & MAY, L.L.P.
1221 McKinney Street
One Houston Center, Suite 2800
Houston, Texas 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778

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CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)Applicant(s): **David L. MALLIS**

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04/26/2001

Examiner

Anthony D. Tugbang

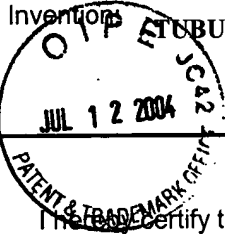
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Group Art Unit

3729

Inventions

TUBULAR JOINT WEAR INDICATOR

I hereby certify that the following correspondence:

Declaration of Robert S. Sivley, IV Under 37 C.F.R. Sec. 1.132 (2 pp.)*(Identify type of correspondence)*

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

July 12, 2004*(Date)***L. Carolyn Nivens***(Typed or Printed Name of Person Mailing Correspondence)**(Signature of Person Mailing Correspondence)***EV 526070890 US***("Express Mail" Mailing Label Number)***Note: Each paper must have its own certificate of mailing.**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : David L. Mallis
Serial No.: 09/843,560
Filed : April 26, 2001
Title : TUBULAR JOINT WEAR INDICATOR

Art Unit : 3729
Examiner : D. Tugbang

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Declaration of Robert S. Sivley, IV Under 37 CFR § 1.132

I, Robert S. Sivley, IV, hereby declare that:

1. I received a Bachelor's Degree in Mechanical Engineering from the Cullen College of Engineering at the University of Houston in 1996.
2. I have worked in the field of Mechanical Engineering for seven years. Since 1996, I have been involved in the design and development of threaded connections.
3. I am licensed to practice mechanical Engineering in the state of Texas. My license number is 92958. It expires on 09/30/2004.
4. I am familiar with the above referenced patent application, and have reviewed the Examiner's rejections.
5. I am currently employed by Hydril Company, Inc.
6. I am not an inventor of the invention that is the subject of the present application.
7. A "shoulder," as the term is used in the art of threaded connections, refers to a device that prevents further relative rotation between two threaded members when the members are made up. One example of a shoulder is a positive stop shoulder, which is where a shoulder element on the pin member comes into contact with a shoulder element on the

box member. The contact between the shoulder elements prevents any further relative rotation between the two members. Another type of shoulder is a thread shoulder, where contact between the flanks of the threads prevents further relative rotation of the members. Any part of a threaded connection that does not prevent further relative rotation between the members is not a shoulder, as that term is used in the art.

8. As I understand the rejection, the Examiner considers element 17 in U.S. Patent No. 4,438,953 ("Timme") to be a wear indicator and surfaces 19 and 23 to be shoulders. In my opinion, the only shoulder shown in FIG. 3 of Timme is shown at element 17. The surfaces 19, 23 shown in FIG. 3 of Timme are not shoulders because they do not prevent relative axial movement between the members of the threaded connection. Thus, Timme does not show a wear indicator that extends from a shoulder, as recited by the claims in the present application.

I further declare that all statements made herein of my own knowledge are true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date:

Paula J. IV 72 04/13/2004